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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,357	09/25/2003	Aziz Hassan	BSN5DIV	6637

7590 11/14/2005

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EXAMINER

CAMERON, ERMA C

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/669,357	<b>Applicant(s)</b> HASSAN ET AL.	
	<b>Examiner</b> Erma Cameron	<b>Art Unit</b> 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-39, 41, 42 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-39, 41, 42 and 45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: -
  - a) the amendment on page 3 line 31 of the 9/2/2005 amendment should be to page 20 not page 30.
  - b) the reference to prov. 60/401382 in the 9/25/2003 prelim. Amendment is incorrect and should be corrected.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1762

3. Claims 30-39, 41-42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeter (6011286).

‘286 teaches enhancing water resistance of materials such as fiberboard (1:54-67) or other fibrous vegetable materials (see Abstract) with a composition of low iodine value (preferably 0-30, 1:40-52) triglyceride fats from plant or animal sources (2:21-46), such as a soy stearine (see Example 1) or a palm triglyceride (1:49). Soy stearine is a triglyceride with stearic acid (4:20-35).

The triglyceride is applied as a powder, an emulsion of a dispersion (see Abstract).

‘286 does not disclose the MP or saponification value of the triglyceride, but because stearine is one of the triglycerides claimed by applicant, the stearine of ‘286 would inherently have the same MP and saponification value as that claimed by applicant.

‘286 does not disclose the viscosity of the wax emulsions used in its examples, but it would have been obvious to one of ordinary skill in the art to have optimized the viscosity through no more than routine experimentation because viscosity is known to be an important parameter to control in coatings.

‘286 does not disclose the addition of dispersants or surfactants, but because the triglyceride may be applied as an emulsion or dispersion, it would have been conventional to add dispersants.

The stearic acid of claim 38 is present in the triglyceride of ‘286.

Dry particles of the triglyceride may be sprayed onto the substrate (3:1-19), which means that the composition is then 100% triglyceride, thereby meeting claim 41.

'286 does not describe recycling the fiber board or other fibrous vegetable materials, but because '286 is using the same triglyceride as applicant, the material is inherently dispersible in warm alkaline aqueous solution. Claims 30 and 45 do not require recycling, only that the composition applied is dispersible in warm alkaline aqueous solution.

The applicant has argued in the 9/2/2005 amendment that '286 teaches the composition for use on OSB. The examiner disagrees that that is the only application. '286 also teaches fibrous vegetable materials (which would be inclusive of paper) and fiber board.

4. Claims 30-38, 41-42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/00815.

'815 teaches applying a coating containing a triglyceride such as tristearin or a hardened vegetable oil to a paperboard, in order to make the coated paperboard more water resistant (page 8) and more repulpable. Tristearin is a triglyceride with stearic acid. Additives such as beeswax, a type of paraffin (page 5), may also be present. The coating composition may be applied in the molten state (p 5), thus meeting the requirements of 100% of claim 41. It is disclosed that the triglycerides may be removed from the paperboard by several different means, including hot water (pp 6-7) and alkaline conditions. See pages 2-7.

Art Unit: 1762

'815 does not disclose the iodine value, MP or saponification value of the triglyceride, but because tristearin is one of the triglycerides claimed by applicant, a triglyceride with stearic acid, the tristearin of '815 would inherently have the same iodine value, MP and saponification value as that claimed by applicant.

'815 does not disclose the viscosity of the wax emulsions used in its examples, but it would have been obvious to one of ordinary skill in the art to have optimized the viscosity through no more than routine experimentation because viscosity is known to be an important parameter to control in coatings.

Additives may be present, which would be inclusive of surfactants (see Example 10). The applicant has argued in the 9/2 amendment that '815 does not teach repulping. The examiner disagrees. Page 8 has repulping as a method of removing triglycerides from paperboard.

5. Claims 30-33 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over RD 392017.

'017 teaches a waterproofing coating for paper that comprises palm stearin with an iodine value of 12.7 or 38.2 and a MP of 50-65 C. The paper is easily recycled. '017 does not teach the recycling method, but it would have been obvious to one of ordinary skill in the art to have selected a conventional method such as a warm alkaline bath.

Art Unit: 1762

*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
ERMA CAMERON  
PRIMARY EXAMINER

Erma Cameron  
Primary Examiner  
Art Unit 1762

November 10, 2005